

REMARKS

REQUEST FOR CONTINUED EXAMINATION

Applicants request continued examination of the instant application under 37 C.F.R. 1.114.

CLAIM AMENDMENTS

Claims 9, 13-14 and 17 are pending. Claims 8, 10-12, 15-16 and 30-41 have been canceled. Claims 1-7 and 18-29 were previously withdrawn from consideration pursuant to a restriction requirement.

The proposed amendments are as follows:

- (a) The cancellation without prejudice of Claims 8, 12, 15-16 and 38-41; and
- (b) The current amendment of Claims 9 and 17.

Upon entry of the proposed amendments, Claims 9 and 12-17 will be pending in the application. The pending independent claim will be Claim 9.

The proposed amendment to Claim 9 presents this claim in independent form and further characterizes an acceptable dosage for eplerenone for the improvement of the quality of life in an individual in need thereof. The proposed amendment to Claim 17 shifts its dependency claim to currently amended Claim 9 from cancelled Claim 8. No new matter has been added. The amended claims are supported by the specification and by the claims as originally filed. Each is limited to the species eplerenone.

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT UNDER 37 CFR 1.97-1.98

A supplemental IDS is filed pursuant to 37 CFR 1.97-1.98 and MPEP §609.

STATEMENT CONCERNING COMMON OWNERSHIP OF CITED REFERENCES AND APPLICATION

U.S. Patent 6,529,902 (Thosar et al.), U.S. Patent Application Publication No. 2004/0077611 (Alexander et al.) and this Application, U.S. Patent Application Serial No. 09/941,206 were, at the time the invention of U.S. Patent Application Serial No. 09/941,206 was made, owned by Pharmacia Corporation. Applicants have provided as attachments to this document "Patent Assignment Abstract of Title" documents for each Thosar et al. and Alexander et al. as available on PAIR (retrieved 18 July 2005). Alexander et al. is assigned to Pharmacia Corporation, as is the instant

case. Thosar et al. is assigned to G.D. Searle & Co., a wholly owned subsidiary of Pharmacia Corporation. Applicants have supplied a third attachment titled "Certificate," which is a notarized document executed by then Vice President and Associate General Counsel and Secretary of Pharmacia Corporation Don W. Schmitz that describes the relationship of G.D. Searle & Co. to Pharmacia Corporation.

CLAIM REJECTIONS UNDER JUDICIALLY CREATED DOCTRINE OF DOUBLE PATENTING

The Office provisionally rejected Claims 8, 17 and 38-41, asserting that the claims were not patentably distinct over Claims 1-18 of copending Application No. 10/440,691 (Alexander et al. – published as US 2004/0077611). Applicants have amended the claims in the present application and have cancelled Claims 8 and 38-41. In addition, the dependency of Claim 17 has been changed to currently amended Claim 9 rather than cancelled Claim 8. This change in dependency, among other changes, restricts the dosage of eplerenone in accordance with the method of the invention disclosed herein and not previously disclosed in Alexander et al. Therefore, Applicants believe the provisional rejection is mooted. However, to expedite prosecution of the instant application, a terminal disclaimer has been attached hereto.

CLAIM REJECTIONS UNDER 35 USC §102(e) – THOSAR ET AL.

The Office rejected claims 8, 17 and 38-41, asserting that the claims were anticipated by Thosar et al. (US Patent No. 6,592,902 B2). Applicants have cancelled claims 8 and 38-41. As referenced above, Applicants have amended claim 17 to depend from currently amended claim 9 rather than cancelled claim 8. Therefore, Applicants believe the rejection is mooted.

CLAIM REJECTIONS UNDER 35 USC §102(e) – ALEXANDER ET AL.

The Office rejected claims 8, 9, 12-17 and 38-41, asserting that the claims were anticipated by Alexander et al. Claims 8, 12, 15-16 and 38-41 have been cancelled. Applicants assert the disclosure cited by the Office was first invented by Alfonzo T. Perez, a co-inventor of the instant application. His declaration under 37 CFR 1.131 accompanies this document and supports prior invention of the claimed subject matter. Therefore, Applicants believe Alexander et al. is disqualified as a reference under 35 USC §102(e) and Applicants believe the rejection is traversed.

CLAIM REJECTIONS UNDER 35 USC §103(a)

The Office rejected claims 9 and 12-17 as being unpatentable over Thosar et al. As indicated above, Applicants indicate Thosar et al. was commonly owned by Pharmacia Corporation at the time of the invention of the instant application. Therefore, Applicants believe Thosar et al. is disqualified as a reference under §103(a) through the application of §103(c) as described in MPEP §706.02. Thus, Applicants believe this obviousness rejection is traversed.

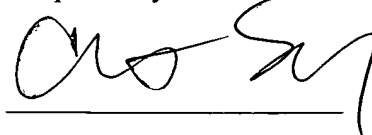
CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot by this amendment. Thus, favorable reconsideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (314) 274-7008 at the Examiner's convenience.

It is believed that a three-month Extension of Time is required to render this paper timely filed. Applicants petition the Commissioner under 37 C.F.R. §1.126(a) for a three-month Extension of Time to respond to render the paper transmitted herewith timely. The Commissioner is hereby authorized to charge any appropriate fees for filing this Amendment and any necessary Extension of Time to Deposit Account 19-1025.

No excess claim fees are believed payable in respect of the present amendment. Further, if there is any other fee deficiency or overpayment of any fees in connection with this patent application, the Commissioner is hereby authorized to charge such deficiency or credit such overpayment to Deposit Account 19-1025.

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